

**REMARKS**

Reconsideration and allowance of the above-referenced application are respectfully requested.

**I. STATUS OF THE CLAIMS**

Claims 1 and 8 are currently amended.

In view of the above, it is respectfully submitted that claims 1-14 are currently pending and under consideration.

**II. REJECTION OF CLAIMS 1-14 UNDER 35 U.S.C. § 103(A) AS BEING UNPATENTABLE OVER KOBAYASHI ET AL (US 6,238,042) IN VIEW OF SHINADA (US 6,899,417) AND FURTHER IN VIEW OF ODA ET AL (US 5,552,816)**

The present invention as recited in claim 1 (as amended herein) relates to an ink cartridge comprising "a cartridge cover having an ink injection port formed thereon and covering a top of the ink chamber and the foam chamber, wherein a lower part of the foam is formed to be larger than an inner shape of the foam chamber, except shapes of the ink filter and the ink head, so that the foam around the ink filter is more compressed than the foam around the opening, wherein the difference between the height of the foam and the height of the foam chamber increases progressively closer to a side of the filter."

Kobayashi teaches an ink cartridge having an ink chamber and a foam chamber. The Examiner agrees that Kobayashi does not teach "a lower part of the foam is formed to be larger than an inner shape of the foam chamber, except shapes of the ink filter and the ink head, so that the foam around the ink filter is more compressed than the foam around the opening" (see claim 1). Therefore, Kobayashi does not teach the features as recited in claim 1 of the present invention.

Shinada teaches an ink-absorbing member 96. However, there is nothing in the Shinada reference that teaches or suggests that "a lower part of the foam is formed to be larger than an inner shape of the foam chamber...so that the foam around the ink filter is more compressed than the foam around the opening" (emphasis added). Therefore, Shinada does not teach the features as recited in claim 1.

Oda teaches an ink-jet recording apparatus. The Examiner points out that Oda teaches an ink tank T attached to the tank holder 11 of the head cartridge H has a bottom wall 21 in which the lower part thereof is partially inclined.

However, the ink tank T is not a foam chamber and does not contain foam on an inside thereof. Like Kobayashi and Shinada, Oda fails to teach or suggest "a cartridge cover having an

ink injection port formed thereon and covering a top of the ink chamber and the foam chamber, wherein a lower part of the foam is formed to be larger than an inner shape of the foam chamber, except shapes of the ink filter and the ink head, so that the foam around the ink filter is more compressed than the foam around the opening" (see claim 1). Therefore, Oda does not teach the features as recited in claim 1.

Accordingly, Kobayashi, Shinada, and Oda, either alone or in combination, do not teach or suggest the features recited in claim 1 of the present invention.

MPEP § 2142 states that "[w]hen the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain why the combination of the teachings is proper." The Examiner is required to present actual evidence and make particular findings related to the motivation to combine the teachings of the references. In re Kotzab, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000); In re Dembiczak, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Broad conclusory statements regarding the teaching of multiple references, standing alone, are not "evidence." Dembiczak, 50 USPQ2d at 1617. "The factual inquiry whether to combine the references must be thorough and searching." In re Lee, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002) (citing McGinley v. Franklin Sports, Inc., 60 USPQ2d 1001, 1008 (Fed. Cir. 2001)). The factual inquiry must be based on objective evidence of record, and cannot be based on subjective belief and unknown authority. Id. at 1433-34. The Examiner must explain the reasons that one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious. In re Rouffet, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998).

The Examiner has not presented any evidence why Kobayashi, Shinada, and Oda would have been combined. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. MPEP § 2143.01. Specifically, there must be a suggestion or motivation in the references to make the combination or modification. Id. The Examiner's sole support for such a combination is that "*it would have been obvious to a person of ordinary skill in the art...to form the foam of Kobayashi et al larger than the foam chamber as suggested by Shinada for the purpose of providing an optimum negative pressure for the rejected ink and forming an incline lower part as suggested by Oda et al in the foam chamber of Kobayashi et al for the purpose of minimizing the collection of residual ink that would reduce wasting ink*" (emphasis added). The Examiner cannot rely on the benefit of the combination without first supporting the motivation to make the combination. Such motivation does not appear anywhere in either reference, and the Examiner has not presented any actual evidence in support of the same. Instead, the Examiner relies on broad conclusory statements, subjective belief, and unknown authority. Such a basis

does not adequately support the combination of references; therefore, the combination is improper and must be withdrawn.

Similar to claim 1, claim 8 (as amended herein) relates to an ink cartridge, "a lower part of the foam is formed to be larger than an inner shape of the foam chamber, except shapes of the ink filter and the ink head, so that the foam around the ink filter is more compressed than the foam around the opening, wherein the difference between the height of the foam and the height of the foam chamber increases progressively closer to a side of the filter." Thus, claim 8 also distinguishes over the cited prior art.

Dependent claims 2-7 (depending, either directly or indirectly, from claim 1) and 9-14 (depending from claim 8) recite patentably distinguishing features of their own and further, are at least patentably distinguishing due to their dependencies from independent claims 1 and 8. For example, in contrast to Oda, dependent claims 3 and 10 provides, "wherein the lower part of the foam chamber is inclined downward from the opening to the ink filter."

In regard to claims 3 and 10, the Examiner asserts, "the modified foam chamber in view of Oda et al would have an incline from the opening (419) to the filter (425)." However, there is nothing in the Oda reference that teaches or suggests that a lower part of a *foam chamber* is inclined downward from the opening to the ink filter. In fact, Oda is silent regarding the teachings of a foam chamber.

In view of the above, it is respectfully submitted that the rejection is overcome.

### **III. CONCLUSION**

In view of the foregoing amendments and remarks, it is respectfully submitted that each of the claims patentably distinguishes over the prior art, and therefore defines allowable subject matter. A prompt and favorable reconsideration of the rejection along with an indication of allowability of all pending claims are therefore respectfully requested.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

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By: Derrick L. Fields  
Derrick L. Fields  
Registration No. 50,133

1201 New York Avenue, NW, Suite 700  
Washington, D.C. 20005  
Telephone: (202) 434-1500  
Facsimile: (202) 434-1501